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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,450	07/27/2001	Jon C. Pergande	WG0096	8745
7590 06/28/2004			EXAMINER	
Terence P. O'Brien Wilson Sporting Goods, Co. 8700 W. Bryn Mawr Avenue Chicago, IL 60631			DUONG, THANH P	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Thur

Office Action Summary	Application No. 09/916,450	Applicant(s) PERGANDE ET AL.	
	Examiner Tom P Duong	Art Unit 1764	

J.C.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8,9,15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-7,10-14,17,18 and 44-50 is/are rejected.
- 7) ☒ Claim(s) 8,9,15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-7, 10-14, 17-18, and 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al. (6,086,485) in view of Nakanishi et al. (4,964,640) and Vincent et al. (6,592,468). Regarding claims 1, 2, and 6, Hamada discloses a golf club head comprising: a striking face 13 including a rearwardly sloped front side and a rear side, a sole portion 11 extending from the lower region of the rear side and a hole 17 or recess extending into the sole portion (Figure 4) and lower region substantially parallel to the front face. Hamada appears to show to show the sole portion including an upwardly extending rear wall having a forwardly facing inner surface (Fig.4) but fails to show the recess being open in an upward direction and having variable rearward depth, the forwardly facing inner surface of the rear wall being substantially non-parallel, and rearwardly sloped with respect, to the lower region of the rear side of the front wall such that the rearward depth of recess is greatest at its upper open end. Nakanishi teaches the a sole portion 3 with upwardly extending portion 8 (Fig. 8) and such undercut facilitate the fixing of the fiber reinforcement within the recess (Abstract). Thus, it would have been obvious in view of

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Nakanishi to one having ordinary skill in the art to modify the sole portion of Hamada with a sole portion extended upwardly to facilitate the fixing and housing of the fiber reinforcement. Hamada also discusses an alternative embodiment as shown in Figure 6 where a filling portion 21 having substance of small specific gravity can be filled in the hollow portion 19 or hole 17. The addition of the filling portion in the head allows the center of gravity to be shifted to the rearward end and such configuration eliminates undesirable deflection of shots (Col. 6, lines 46-55). Hamada does not disclose the specific filing material as being a resilient insert. Vincent discloses that the substrate 71 (insert) have sufficient hardness and elasticity to dissipate energy (Col. 7, lines 49-60). In addition, it would have been obvious in view of Vincent to one having ordinary skill in the art to optimize the insert hardness to maximize dissipation of energy. Thus, it would have been obvious and desirable in view of Vincent to one having ordinary skill in the art to substitute the substrate of Vincent in lieu of the filing portion of Hamada in order to control the center of gravity and dissipate energy. Regarding claims 3, 4, 7, and 10, Vincent teaches a resilient insert assembly forming of a sleeve 90 positioned proximate cartridge 80 (Figs. 7-7 and Col. 8, lines 58-65), which constitutes a first and second insert. Regarding claim 5, Vincent discloses the first insert, cartridge material made of a metal substrate filled with polymeric material (Col. 3, lines 15-22) and the second insert, substrate made of polymeric material, which has different hardness than the cartridge. Regarding claim 11, Vincent discloses the insert material of the claimed invention (Col. 7, lines 49-50). Regarding claim 12, it is conventional to provide a cap or cover plate and it

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would have been obvious to do so here in order to provide indentation graphics or manufacturer logos in the cap. Claims 13-14, 17-18, and 44-50 recite limitations similar to claims 1-7 and 10-12; thus, claims 13-14, 17-18, and 44-50 are rejected for the same reasons as applied to claims 1-7 and 10-12, above.

Allowable Subject Matter

Claims 8-9 and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-18 and 44-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (571) 272-2794. The examiner can normally be reached on 8:00AM - 4:30PM.

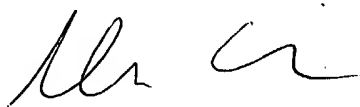
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Duong
June 15, 2004

TD



Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700